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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	COMMERCIAL CLASS
10 021 857	12 17 2001	John M. Saville	45930 VGG N123	991

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CHRISTIE, PARKER & HALE, LLP
350 WEST COLORADO BOULEVARD
SUITE 500
PASADENA, CA 91105

EXAMINER

LOCKER, HOWARD J

APPROVED FOR SIGNATURE

DATE MAILED 11/1/01

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Please find below and or attached an Office communication concerning this application or proceeding.



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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

2

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on December 17, 2001

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ ~~Claim(s)~~ The claim is ~~is~~ pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ ~~The claim is~~ ~~is~~ rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

10/02/857
PTOL-326 (Rev. 10/95)

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit 1601

1. The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

"The specification shall contain a written description of the invention and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention."

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

"No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described."

The following is a quotation of the second paragraph of 35 U.S.C. 112:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

"The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted."

The disclosure is objected to under 37 CFR 1.163(a) and under 35 USC 112, first paragraph, because the specification presents less than a full, clear and complete botanical description of the plant and the characteristics which define same per se, and which distinguish same over related or similar known cultivars and antecedents.

More specifically:

A. The botanical classification of the subject plant should be positively set forth in the specification

B. As application serial number 09/727065 has now matured into United States Plant Patent Number 13,055 to Savapple, the specification should be amended to indicate same

C. The recitation 'hip/step position' as set forth at page 5 of the specification is not understood, particularly as the specification later states that no hips have been observed. It would appear that applicant perhaps intended "sepals" instead

D. The recitation at page 5 of the specification "Peduncle with receptacle and sepals die and remain attached to the plant" does not make sense as drafted. Correction and/or clarification is necessary.

E. That the blooms are borne singly does not appear to be borne out by the submitted illustration. Correction is necessary. If the blooms are sometimes borne singly as well as in small clusters, the specification should be amended to so indicate.

F. The recitation at page 5 "Only the petals drop off cleanly between 7 to 9 days" does not read clearly, and it cannot be determined what is intended or encompassed by same

G. The recitation at page 7, "Notable Characteristics: None" does not make sense. Correction and/or clarification is necessary.

H. That the mature "leaflet" is 3 3/8 inches in length does not appear to be accurate. It would appear, both from the dimensions set forth and from reference to the rachis, that the compound leaf is being described at this point in the specification (page 8, line 20-23). The specification should be amended to so indicate, as well as setting forth whether the compound leaf thus described is a 5-leaflet leaf.

I. The information currently set forth at lines 15-24 of page 9 appears to be redundant to that set forth earlier in the specification, and additionally does not appear to be properly indented under rachis. Correction and/or clarification is necessary.

J. The recitation "just more than average" does not read clearly and does not positively convey meaningful information (page 10, line 20-21). Correction and/or clarification is necessary.

K. At page 11 the specification states "some prickles observed on older leaves". If such is intended to reflect the rachis/petiole, the specification should be amended to so state. The present recitation would appear to be less than accurately set forth.

The above listing may not be comprehensive. Applicant should carefully review the disclosure and import into same any additional or corrected information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is being sought.

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2. The claim is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant, for the reasons set forth in paragraph 1 above.

3. Applicant is advised of the new optional procedures for amending the specification and claim under 37 CFR 1.121. The new procedures are optional until July, 2003, and such may become mandatory at that time. Applicant may review same on the internet at the following site:
<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/revamdtpra.htm>

4. Any inquiry concerning this communication from the examiner should be directed to Examiner Howard J. Locker whose telephone number is 703-308-2924, and whose normal work hours are Monday through Thursday, from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Bruce Campbell, can be reached at 703-308-4205.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

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TELECOPY/FACSIMILE TRANSMISSION

Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to this Group via the PTO Fax Center in Crystal Mall 1 (CM 1). The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM 1 Fax Center number is 703-308-4556 or 703-305-3592.

Howard J. Locker/hjl

April 03, 2003


HOWARD J. LOCKER
EXAMINER
GROUP ART UNIT 1661